

Remarks

This Application has been carefully reviewed in light of the Final Office Action dated October 15, 2004. Applicant has made clarifying amendments to independent Claims 1, 11, 21, and 31. These amendments are not considered necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Consideration of Previously-Filed Information Disclosure Statement

Applicants mailed Information Disclosure Statements (IDSs) and accompanying PTO-1449 forms on March 9, 2004 and August 4, 2004, but the submitted references were not indicated as considered by the Examiner in this Final Office Action. Applicants respectfully request the Examiner to indicate consideration of the submitted references by initialing next to each reference on the PTO-1449 forms. For the Examiner's convenience, copies of the IDSs and PTO-1449 forms are attached to this Response. Moreover, Applicants respectfully submit that because these IDSs were submitted prior to the mailing of this Final Office Action, Applicants were entitled to have these references considered prior to the issuance of a Final Office Action in this case. Thus, Applicants respectfully submit that they are entitled to have the finality of the current Office Action withdrawn.

II. Claims 1-34 Comply with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claims 1-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully disagrees.

In particular, the Examiner maintains that the phrase "not substantially affecting" in Claims 1, 11, 21, and 31-34 renders those claims indefinite "because it is unclear how exactly the authorized use of data are not being affected." (Final Office Action, Page 3)

In the previous Response, Applicant submitted that one of ordinary skill in the art would understand "the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers," as recited in Claim 1 for example. Additionally, Applicant directed the Examiner's attention to at least Page 27, Line 11 through Page 28,

Line 5 and Page 29, Lines 21-31 of the Specification, which provide an example description of this limitation.

Rather than provide any substantive response to these arguments in the Final Office Action, the Examiner summarily concludes that “the phrase ‘not substantially affecting’ is indeed indefinite.” (Final Office Action, Page 2) Applicant again respectfully disagrees.

Applicant again notes that the essential inquiry pertaining to this requirement is whether the claims set out and circumscribe subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Furthermore, the test for indefiniteness under Section 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)).

Moreover, the M.P.E.P. and the Federal Circuit clearly condone the use of the term “substantially” in claims. See M.P.E.P. § 2173.05(b).D citing *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 U.S.P.Q.2d 2010 (Fed. Cir. 1988). Additionally, Applicant respectfully maintains that the meaning and scope of Claim 1, for example, would be clear to one of ordinary skill in the art at the time of invention, whether the claim is read alone or in combination with the Specification. Applicant again respectfully directs the Examiner’s attention to at least Page 27, Line 11 through Page 28, Line 5 and Page 29, Lines 21-31 of the Specification, which provide an example description of this limitation. For example, Applicant’s Specification provides the following example description of this limitation:

Data found to contain one or more particular watermarks may be identified as a copy of data from a proprietor that uses those watermarks. In this way, the original source of the data may be identified. Data may be watermarked by one or more sifting functions or other suitable algorithms that may create identifiable “signature” patterns in the data. In certain embodiments, a sifting function may create a signature pattern in data stored in a database by making insertions, deletions, and/or alterations of printable

American Standard Code for Information Interchange (ASCII) characters or other items in the data according to a distinct pattern. *The insertions, deletions, and/or alterations made by the sifting function may be such that they do not interfere with searches against the data, change the meaning of certain data, or otherwise adversely affect the data or their use. As an example, a sifting function may capitalize every tenth lower-case instance of certain letters (or other suitable characters) moving left to right and down within a relation database. As another example, a sifting function may insert hyphens between words or other character groups within certain data fields within a database. As another example, a sifting function may underscore certain instances of text or other characters within a database. As another example, columns not containing any information (or not containing information that may interfere with searches against the data) may be inserted according to a distinct pattern.* Although particular examples of signature patterns using printable ASCII characters have been described herein, the present invention contemplates any suitable pattern or combination of patterns that may be used to identify data and their source.

In addition or as an alternative, a sifting function may create a signature pattern in data within a database by making insertions of non-printable ASCII characters or other items in the data according to a distinct pattern. *The insertions made by the sifting function may be such that they do not interfere with searches against the data, change the meaning of certain data, or otherwise adversely affect the data or their use. As an example only and not by way of limitation, such a sifting function may insert one or more particular non-printable ASCII characters after each instance of certain words or other character groups or in between the same. The inserted characters may be "hidden" such that they do not appear when the data is displayed, printed, or otherwise made available for viewing, but their presence among the data may be detected by, for example, an appropriate application to identify the data and their source.*

(Page 27, Line 4 through Page 28, Line 5; emphasis added)

Claim 1 and its dependent claims, particularly when read in light of Applicant's Specification, are definite. For substantially similar reasons, independent Claims 11, 21, and 31-34 and their respective dependent claims are definite.

Furthermore, the M.P.E.P provides, "[I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph [which, as discussed above, Applicant believes it does], but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112,

second paragraph, rather, the examiner should suggest improved language to the applicant.” M.P.E.P. § 2173.02. If the rejection under 35 U.S.C. § 112, second paragraph, was the only issue remaining in the Application, Applicant would consider amending Claim 1 (and the other independent claims) according to a suggestion from the Examiner. However, given that the Examiner has not provided such a suggestion and, as discussed above, the Examiner has not thoroughly addressed Applicant’s arguments made with respect to the rejections under 35 U.S.C. § 112, second paragraph, Applicant has not made such amendments in this Response.

For at least these reasons, Applicant respectfully submits that Claims 1, 11, 21, and 31-34 clearly comply with 35 U.S.C. § 112, second paragraph. Thus, Applicant respectfully requests reconsideration and allowance of Claims 1, 11, 21, and 31-34 and their respective dependent claims.

III. Applicant’s Claims are allowable under 35 U.S.C. § 103(a)

A. Claims 1-5, 8, 11-15, 18, 21-25, 28, and 31 are Allowable over the Proposed *Ogilvie-Walker* Combination

The Examiner rejects Claims 1-5, 8, 11-15, 18, 21-25, 28, and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,343,738 to Ogilvie (“*Ogilvie*”) in view of U.S. Patent 6,249,772 to Walker, et al. (“*Walker*”). Applicant respectfully disagrees and discusses Claim 1 as an example.

1. The Proposed *Ogilvie-Walker* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Claim 1

Ogilvie discloses “sampling, escrowing, and other tools and techniques for facilitating transactions that involve digital goods.” (Abstract) According to the system disclosed in *Ogilvie*, digital goods may be escrowed with an automatic broker, which may create and distribute samples of the digital goods. (Abstract) The samples of the digital goods are created using techniques such as distorting or burdening part or all of a copy of the goods. (Abstract)

In contrast, Applicant's Claim 1, as amended, recites:

A system for watermarking data associated with one or more products, the system comprising one or more software components collectively operable to:

generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers, the data comprising one or more of product attribute values for each of the one or more products, seller attribute values for each of the one or more products, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers; and

apply the algorithm to the data to create the particular pattern in the data.

Ogilvie, whether considered alone or in combination with *Walker*, fails to disclose, teach, or suggest various limitations recited in Claim 1.

For example, *Ogilvie* fails to disclose, teach, or suggest "generat[ing] an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers," as recited in Claim 1 prior to the amendments presented in this Response. First, Applicant reiterates the arguments made in the previous Response. In particular, the Examiner equates the "one or more products" recited in Claim 1 with the digital goods disclosed in *Ogilvie* and the "data" recited in Claim 1 with the sample of the digital goods disclosed in *Ogilvie*. (See Final Office Action, Page 4) However, the sampling techniques performed by the system disclosed in *Ogilvie* are performed on the digital goods (which the Examiner equated with the one or more products recited in Claim 1) to create the sample of the digital goods. In contrast, the algorithm recited in Claim 1 is generated for creating a particular pattern *in data associated with one or more products* and is *applied to the data associated with the one or more products*. In *Ogilvie*, the sample that the Examiner equates with the data recited in Claim 1 does not even exist until after the sampling techniques are

applied to the digital goods, which the Examiner equates with the one or more products recited in Claim 1. Thus, Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between the *Ogilvie* and Claim 1 cannot be made. Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish Claim 1 from *Ogilvie*.

In response to similar arguments presented by Applicant in the previous Response, the Examiner states that "the sample data referred [to] by the examiner is the data that [is] used for sampling, which originally existed within the digital goods prior to the sampling techniques." (See Office Action, Page 2) This position, however, does not support the Examiner's rejection. The "data that [is] used for sampling" in *Ogilvie* are the digital goods. Applicant respectfully submits that the Examiner cannot properly equate the digital goods in *Ogilvie* with both the "one or more products" and the "data" recited in Claim 1. The sampling techniques performed by the system disclosed in *Ogilvie* clearly are performed on the digital goods to create the sample of the digital goods, and the sample disclosed in *Ogilvie* does not exist until after the sampling techniques are applied to the digital goods.

Even more clearly, *Ogilvie* fails to disclose, teach, or suggest "the data comprising one or more of product attribute values for each of the one or more products, seller attribute values for each of the one or more products, and product descriptions for each of the one or more products," as recited in Claim 1 as amended. The Examiner essentially acknowledges this deficiency of *Ogilvie* in the Examiner's rejection of dependent Claim 4. (See Final Office Action, Page 6)¹ However, the Examiner argues that "Walker teaches data associated with one or more products comprises one or more product attribute values (*i.e. model number in Fig. 6A*), seller attribute values (*i.e. seller's price in Fig. 6A*), and product descriptions (*i.e. item description in Fig. 6A*)."¹ Whether or not "product attribute values," "seller attribute values," and "product descriptions" existed at the time of Applicant's invention, the salient question is whether the prior art would have motivated one of ordinary skill in the art at the time of Applicant's invention to "generate an algorithm for creating a particular pattern in

¹ Applicant notes that Claim 4, for example, and the amendments to Claim 1, for example, are of different scope. Thus, Applicant's discussion of the Examiner's rejection of Claim 4 is merely offered in anticipation of the Examiner's response to the amendments made to Claim 1, for example.

[such] data associated with one or more products available from one or more sellers,” as recited in Claim 1 as amended. As Applicant discusses below in Section III.B, Applicant respectfully submits that it would not have.

Moreover, a purpose of the sampling techniques disclosed in *Ogilvie* (which the Examiner equates with the “algorithm for creating a particular pattern in data associated with one or more products,” as recited in Claim 1) is to “permit the buyer to inspect the goods without thereby making the goods available for use by the buyer without purchase.” (Column 7, Lines 1-3) The data to which the sampling techniques are applied in the system disclosed in *Ogilvie* (the digital product) is to be distorted such that the buyer cannot use the digital goods unless the buyer purchases the digital goods associated with the sample. In contrast, the algorithm that is generated and applied in Claim 1 is “for creating a particular pattern in data associated with one or more products . . . the pattern facilitating identification of a copy of the data ***and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyer computers.***” Thus, authorized use of the data to which the algorithm is applied in Claim 1 is not substantially affected by the pattern. Applicant notes that the Examiner did not respond to a substantially similar argument made by Applicant in the previous Response.

Walker fails to make up for these deficiencies of *Ogilvie*.

As another example, for similar reasons to those discussed above, *Ogilvie* fails to disclose, teach, or suggest “apply[ing] the algorithm to the data to create the particular pattern in the data.” Again, the sampling techniques discussed in *Ogilvie* are applied to the digital products to create the samples. The sampling techniques are not applied to the samples, which the Examiner equates with the data recited in Claim 1.

The Examiner acknowledges, and Applicant agrees, that *Ogilvie* fails to teach “the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products.” (Office Action, Page 3; emphasis in original) However, the Examiner asserts that *Walker* teaches “buyers’ search queries among databases for data associated with certain of the products.” (Office Action,

Pages 3-4; citations omitted) Whether or not this is true, Applicant respectfully submits that the Examiner still has not shown the required teaching, suggestion, or motivation to combine *Ogilvie* with *Walker* in the manner the Examiner proposes, as discussed below.

B. The Proposed *Ogilvie-Walker* Combination is Improper

Applicant maintains that the Examiner has not shown the required teaching, suggestion, or motivation in *Ogilvie*, *Walker*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify *Ogilvie* and *Walker* in the manner the Examiner proposes. Applicant again respectfully submits that the Examiner's conclusory assertion that it would have been obvious to combine the teachings of *Ogilvie* with the teachings of *Walker* to arrive at Applicant's invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law. The rejected claims are allowable for at least this reason.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Ogilvie-Walker* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicant respectfully submits that the Examiner has merely pieced together disjointed portions of unrelated references, with the benefit of hindsight using Applicant's claims as a blueprint, to reconstruct Applicant's claims.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. *The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. See Id.* (citations omitted). *"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention."* M.P.E.P. § 2143.01 (emphasis added). *Even the fact that references can be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.² According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* *Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*

² Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

In re Mills, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the

Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With regard to the proposed *Ogilvie-Walker* combination made with respect to Claim 1, the Examiner indicates that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data stored in one or more databases in Ogilvie’s teaching to be searched as taught by Walker because this would allow buyers to quickly and easily search desired information.” (Final Office Action, Page 5) First, the data stored in a database in the system disclosed in *Ogilvie* that is available to the buyers appear to be the samples of the digital goods. (See Figure 11) There is nothing in *Ogilvie* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to include a searching capability of the samples. In *Walker*, the buyer is able to specify a geographic location, product choices, product feature sets, price ranges, etc. The search engine scans appropriate database tables to produce and provide lists of retailers in a particular geographic location (e.g., the specified location of the user computer) normally stocking products having particular traits selected by the user and which are sold at identified prices as set and established by a manufacturer. (See Column 9, Line 64 through Column 10, Line 5) There is nothing in *Walker* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to include generation and application of the sampling techniques disclosed in *Ogilvie*.

With regard to the proposed *Ogilvie-Walker* combination made with respect to Claim 4, the Examiner indicates that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data in Ogilvie’s teaching to include product

attribute values, seller attribute values, and product descriptions because this would allow the buyers to better determine if certain products meet their needs.” (Final Office Action, Page 6)

Regarding both of the Examiner's alleged motivations for combining these references, the Examiner has merely proposed alleged advantages of combining *Ogilvie* with *Walker* (advantages which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of either *Ogilvie* or *Walker* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the automatic broker tools and techniques disclosed in *Ogilvie* with the systems and methods disclosed in *Walker*. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, **to even attempt** to incorporate into the automatic broker tools and techniques disclosed in *Ogilvie* such systems and methods as disclosed in *Walker*. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, **to actually** incorporate into the automatic broker tools and techniques disclosed in *Ogilvie* such a systems and methods as disclosed in *Walker*, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Ogilvie* with *Walker* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicant respectfully submits that the Examiner's proposed combination of *Ogilvie* with *Walker* appears to be merely an attempt to reconstruct Applicant's claims, with the benefit of hindsight using Applicant's claims as a blueprint, and is unsupported by the teachings of *Ogilvie* and *Walker*. Applicant respectfully submits that the rejection must therefore be withdrawn.

In response to the above arguments as presented by Applicant in the previous Response, the Examiner states, “In the case of combining *Ogilvie* and *Walker* (U.S. Patent 6,249,772), although *Ogilvie* does not specifically teach searching capability for data, the

search capability for data is taught by Walker and such capability is widely used and well known in the art for internet purchas[ing]." (Final Office Action, Page 3) Applicant respectfully submits that the Examiner's response involves nothing more than stating that because two teachings allegedly existed at a particular time, it would have been obvious to combine those teachings. There is simply no support in the M.P.E.P. or the controlling Federal Circuit decisions for such "hindsight reasoning." In fact, the rules and case law make clear that this is exactly the kind of "hindsight reasoning" that the requirement to show a teaching, suggestion, or motivation in the cited references is designed to prohibit. Applicant respectfully directs the Examiner's attention to the above-cited standard for proving a *prima facie* case of obviousness, particularly to the emphasized portions of the standard. Applicant respectfully submits that the Examiner has not met this burden merely by asserting that certain teachings were allegedly known at the time of Applicant's invention.

As demonstrated above, Applicant respectfully submits that *Ogilvie* is wholly inadequate as a reference against independent Claim 1. Thus, even if *Walker* did disclose the portions of Claim 1 that the Examiner asserts it discloses, and even assuming for the sake of argument that there was the required teaching, suggestion, or motivation to combine *Ogilvie* with *Walker* as the Examiner proposes, the proposed *Ogilvie-Walker* combination would still fail to disclose, teach, or suggest the limitations specifically recited in independent Claim 1, as is required under the M.P.E.P. and the governing Federal Circuit cases for a *prima facie* case of obviousness.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 11, 21, and 31, and their respective dependent claims.

IV. Claims 6-7, 16-17, 26-27, and 32-34 are Allowable over the Proposed *Ogilvie-Walker-Kuo* Combination

The Examiner rejects Claims 6-7, 16-17, 26-27, and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over *Ogilvie* in view of *Walker*, and further in view of Kuo, et al., U.S. Patent 6,230,288 ("*Kuo*"). Applicant respectfully disagrees.

A. Dependent Claims 6-7, 16-17, and 26-27 are Allowable

With respect to the rejection of dependent Claims 6-7, 16-17, and 26-27, these claims depend from independent Claims 1, 11, and 21, respectively, which Applicant has shown above to be clearly allowable over the proposed *Ogilvie-Walker* combination. Applicant respectfully submits that *Kuo* fails to make up for any of the deficiencies of *Ogilvie* and *Walker* discussed above. Thus, Claims 6-7, 16-17, and 26-27 are allowable at least because of their dependence on Claims 1, 11, and 21, respectively. In addition, Claims 6-7, 16-17, and 26-27 recite further patentable distinctions over the prior art of record. To avoid burdening the record and in view of the clear allowability of Claims 1, 11, and 21, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the proposed combination of *Ogilvie*, *Walker*, and *Kuo* is possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 6-7, 16-17, and 26-27.

B. Independent Claims 32-34 are Allowable

Independent Claim 32, for example, recites:

A system for watermarking data associated with one or more products, the system comprising one or more software components collectively operable to:

generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers, the data comprising one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products, the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products, the pattern comprising a plurality of non-printable American Standard Code for Information Interchange (ASCII) characters inserted throughout the data according to a pre-defined arrangement, the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer or users associated with the buyer computers; and
apply the algorithm to the data to create the particular pattern in the data.

The proposed *Ogilvie-Walker-Kuo* combination fails to disclose, teach, or suggest various limitations recited in Claim 32.

First, Applicant respectfully submits that *Ogilvie* is inadequate as a primary reference against Claim 32 for analogous reasons to those discussed above with reference to independent Claim 1. Both *Walker* and *Kuo* fail to make up for the deficiencies of *Ogilvie*. Additionally, Applicant respectfully reiterates that the Examiner has not shown the required teaching, suggestion, or motivation in either *Ogilvie* or *Walker* to combine or modify these references in the manner the Examiner proposes.

Second, the Examiner acknowledges, and Applicant agrees, that both *Ogilvie* and *Walker* fail to teach “the ASCII characters are non-printable.” (Office Action, Page 6; emphasis in original) However, the Examiner argues that *Kuo* teaches inserting non-printable ASCII characters into a file. (Final Office Action, Page 6) *Kuo* is directed to a method for treating whitespace during virus detection and has nothing to do with automatic broker tools and techniques (*Ogilvie*) or systems and methods wherein a buyer purchases a product at a first price and acquires the product from a merchant that offers the product for sale at a second price (*Walker*). Thus, Applicant respectfully submits that there is no teaching, suggestion, or motivation in the cited references to combine or modify these references in the manner suggested by the Examiner.

In response to similar arguments presented in Applicant's previous Response, the Examiner states, “[T]he non-printable ASCII characters [are] taught by *Kuo*, and such technology is generally available to one of ordinary skill in the art.” (Final Office Action, Page 3)

Applicant reiterates the heavy burden placed on the Examiner to demonstrate a *prima facie* case of obviousness. Applicant respectfully submits that the Examiner has not met this burden. In particular, the Examiner has again apparently concluded that because two teachings existed at a particular time, those teachings are necessarily combinable. There is simply no support in the M.P.E.P. or the controlling Federal Circuit decisions for such “hindsight reasoning.” In fact, the rules and case law make clear that this is exactly the kind

of "hindsight reasoning" that the requirement to show a teaching, suggestion, or motivation in the cited references is designed to prohibit. Applicant again respectfully directs the Examiner's attention to the above-cited standard for proving a *prima facie* case of obviousness, particularly to the emphasized portions of the standard. Applicant respectfully submits that the Examiner has not met this burden merely by asserting that certain teachings were allegedly known at the time of Applicant's invention.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 32. For at least the reasons stated with regard to independent Claim 32, Applicant respectfully requests reconsideration and allowance of independent Claims 33-34.

V. Dependent Claims 9-10, 19-20, and 29-30 are Allowable

The Examiner rejects Claims 9, 19, and 29 under 35 U.S.C. § 103(a) as being unpatentable over *Ogilvie* in view of *Walker*, and further in view of U.S. Patent 4,648,047 to Berkland, et al. ("*Berkland*"). The Examiner also rejects Claims 10, 20, and 30, under 35 U.S.C. § 103(a) as being unpatentable over *Ogilvie* in view of *Walker*, and further in view of U.S. Patent 6,094,722 to Astola, et al. ("*Astola*").

Claims 9-10, 19-20, and 29-30 depend from independent Claims 1, 11, and 21, respectively, which Applicant has shown above to be clearly allowable over the proposed *Ogilvie-Walker* combination. Applicant respectfully submits that both *Berkland* and *Astola* fail to make up for any of the deficiencies of *Ogilvie* and *Walker* discussed above. Thus, Claims 9-10, 19-20, and 29-30 are allowable at least because of their dependence on Claims 1, 11, and 21, respectively. In addition, Claims 9-10, 19-20, and 29-30 recite further patentable distinctions over the prior art of record. To avoid burdening the record and in view of the clear allowability of Claims 1, 11, and 21, Applicant does not specifically discuss these distinctions in this Response. However, Applicant reserves the right to discuss these distinctions in a future Response or on Appeal, if appropriate. Furthermore, Applicant does not admit that the proposed combination of *Ogilvie*, *Walker*, and *Berkland* and the proposed combination of *Ogilvie*, *Walker*, and *Astola* are possible or that the Examiner has demonstrated the required teaching, suggestion, or motivation to combine these references.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 9-10, 19-20, and 29-30.

VI. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicants believe no other fees are due. If this is not correct, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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Date: December 15, 2004

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